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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,791	07/14/2003	Shinjiro Hara	BD-0302T	4079

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TAKEUCHI & KUBOTERA, LLP  
200 DAINGERFIELD RD. SUITE 202  
ALEXANDRIA,, VA 22314

EXAMINER
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SEVERSON, JEREMY R

ART UNIT	PAPER NUMBER
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3653

MAIL DATE	DELIVERY MODE
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02/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/617,791

Applicant(s)

HARA ET AL.

Examiner

JEREMY R. SEVERSON

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,8 and 11-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,8,11-20 and 23-30 is/are rejected.
- 7) ☒ Claim(s) 21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's representative, Kazunao Kubotera, contacted the Examiner to notify him that the Final Rejection mailed 27 November 2007 was mistakenly sent to the wrong address. In response, this Office action is being mailed to the correct address, and the statutory period for reply is based on the mailing of this action.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 16, 25, 26 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite a folding member which is composed of an upper guide, and further that the upper guide comprises a rear supporter disposed at a position closer to the image recording apparatus than that of the folding member. If the rear supporter is part of the folding member, it is impossible for it to be closer to the image recording apparatus than that of the folding member.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

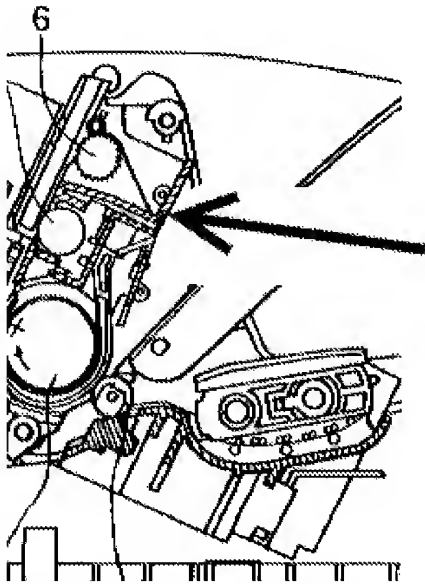
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 6, 8, 11, 12, 19, 20, 23, 24 and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishiberi (US 5,984,300).

Re claims 1, 11, 19 and 29, Nishiberi discloses a medium tray attachable to an image recording apparatus for feeding a record medium one by one and recording an image on said record medium, said medium tray comprising: a depository in which a plurality of said record media is loaded such that front and rear portions of said record media have different angles with respect to a feeding direction of said record media when said record media are in said depository, said depository including a medium support (downstream portion of 9) for placing the front portions of the record media and a rear guide (upstream portion of 9) extending upwardly from a rear end of the medium support for guiding the rear portions of the record media upwardly, said medium support protruding outside of the image recording apparatus from a side of the image recording apparatus to be exposed; and a folding member 2 provided at a rear portion of said depository for folding the record media so that the rear portions of the record media are folded toward the image recording apparatus with upper surfaces of the record media inward, said folding member being disposed at an upper portion of the rear guide, said folding member including a guide member for guiding the record media toward the image recording apparatus. The surface of 2 on which the record medium rests serves to guide the sheet.

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Re claims 3 and 6, Nishiberi discloses everything claimed, including a restricting member arranged at said medium support or rear guide and restricting said record media put in said depository such that said record media are not spaced from said medium support or rear guide more than a predetermined distance and is transported along said medium support or rear guide when said record media are fed into said image recording apparatus. Arrow in fig. below points to restricting member.



Re claim 4, Nishiberi discloses the medium tray according to claim 1, wherein said depository further comprises a curved section between said medium support and rear guide. Elements 9 and 2 are curved along their entire length.

Re claim 8, Nishiberi discloses the medium tray according to claim 1, which further comprises at least one rear supporter 2 provided above said depository at a

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position closer to the image recording apparatus than that of the folding member for supporting the rear portions of said record media folded at said folding member.

Re claims 12 and 27, Nishiberi discloses the medium tray according to claim 8, wherein said rear supporter is made of at least one shaft 2c.

Re claim 20, Nishiberi discloses an image recording apparatus comprising said medium tray according to claim 1, wherein the rear portions of said record media folded at said folding member are supported by an upper surface of said image recording apparatus. See fig. 3.

Re claim 23, Nishiberi discloses everything claimed, wherein said at least one rear supporter is arranged to be rotatable around a fulcrum 2c provided on the medium support.

Re claim 24, Nishiberi discloses everything claimed, wherein said at least one rear supporter is arranged to form an opening for receiving the rear portion of the record medium placed on the medium support when the at least one rear supporter opens. When element 2 is opened, an opening exists for allowing the sheets to enter the machine.

Re claim 28, Nishiberi discloses the medium tray according to claim 1, wherein said folding member includes an upper guide 2 extending from an top end of the rear guide 9 toward a main body of said image recording apparatus such that the upper guide covers the rear guide, said upper guide being made of at least one shaft 2c.

Re claim 30, Nishiberi discloses the medium tray according to claim 29, further comprising at least one rear supporter disposed at a position closer to the image

recording apparatus than that of the folding member for supporting the rear portions of the record media.

Claims 13-18, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Tamura (US 6,469,811).

Re claims 13 and 16 Tamura discloses a medium tray attachable to an image recording apparatus for feeding a record medium one by one and recording an image on said record medium, comprising: a depository in which a plurality of said record media is loaded such that front and rear portions of said record media have different angles with respect to a feeding direction of said record media when said record media are in said depository, said depository including a medium support (downstream section of 3) for placing the front portions of the record media and a rear guide (upstream section of 3) extending upwardly from a rear end of the medium support for guiding the rear portions of the record media upwardly, said medium support protruding outside of the image recording apparatus from a side of the image recording apparatus to be exposed; and a folding member 10 provided at a rear portion of said depository such that rear portions of said record media in said depository are folded toward said image recording apparatus with upper surfaces of the record media inward, said folding member being disposed at an upper portion of the rear guide, wherein said folding member being composed of said rear guide and an upper guide 10 extending from a top end of said rear guide toward a main body of said image recording apparatus such that said upper guide covers said rear guide.

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Re claim 14, Tamura discloses the medium tray according to claim 13, wherein said upper guide can be opened or closed with a side of said main body of said image recording apparatus as a fulcrum. See e.g., figs. 1 and 2.

Re claim 15, Tamura discloses the medium tray according to claim 13, wherein said upper guide comprises a rear supporter 10 disposed at a position closer to the image recording apparatus than that of the folding member for supporting the rear portions of said record media put in said depository.

Re claim 17, Tamura discloses the medium tray according to claim 13, wherein said rear guide is made of at least one shaft 13.

Re claim 18, Tamura discloses the medium tray according to claim 13, wherein said upper guide is made of at least one shaft 13.

Re claim 25, Tamura discloses the medium tray according to claim 16, wherein said at least one rear supporter is arranged to be rotatable around a fulcrum 13 provided on the medium support.

Re claim 26, Tamura discloses the medium tray according to claim 25, wherein said at least one rear supporter is arranged to form an opening for receiving the rear portion of the record medium placed on the medium support when the at least one rear supporter opens. When element 10 is opened, an opening exists for allowing the sheets to enter the machine.

***Allowable Subject Matter***



Claims 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 12 September 2007 have been fully considered but they are not persuasive.

Applicant argues that “[i]n Nishiberi, there is no description or suggestion regarding the depository loading a plurality of the record media and the folding member folding the record media, so that the rear portions of the record media are folded toward the image recording apparatus with upper surfaces of the record media inward. Accordingly, Nishiberi does not disclose all of the features of the invention recited in claim 1.” The examiner respectfully disagrees. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, Nishiberi is capable of loading a plurality of the record media and the folding member folding the record media, so it meets the claim. In response to applicant's argument that Nishiberi does not disclose loading a plurality of media, the Examiner notes that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

Applicant further argues that "[i]n Nishiberi, there is no description or suggestion regarding the rear supporter provided above the depository at a position closer to the image recording apparatus than that of the folding member for supporting the rear portion of the record medium folded at the folding member. Accordingly, Nishiberi does not disclose all of the features of the invention recited in claim 11. Therefore, the invention recited in claim 11 is not anticipated by Nishiberi." The examiner respectfully disagrees. As noted in the 112 rejections above, such features as described by the claims render the claims indefinite.

Applicant further argues that "[i]n Tamura, there is no description or suggestion regarding the depository loading a plurality of the record media and the folding member provided at a rear portion of the depository such that rear portions of the record media in the depository are folded toward the image recording apparatus with upper surfaces of the record media inward. Accordingly, Tamura does not disclose all of the features of the invention recited in claim 13. Therefore, the invention recited in claim 13 is not anticipated by Tamura." The examiner respectfully disagrees for reasons similar to those given regarding the claim 1 rejection above. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, Tamura is capable of loading a plurality of the record

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media and the folding member folding the record media, so it meets the claim. In response to applicant's argument that Tamura does not disclose loading a plurality of media, the Examiner notes that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969).

Applicant further argues that "[i]n Tamura, there is no description or suggestion regarding the rear supporter disposed at a position closer to the image recording apparatus than that of the folding member for supporting the rear portion of the record medium placed in the depository, and the rear supporter holding the rear portion of the record medium such that the rear portion is rolled up. Accordingly, Tamura does not disclose all of the features of the invention recited in claim 16. Therefore, the invention recited in claim 16 is not anticipated by Tamura." The examiner respectfully disagrees. As noted in the 112 rejections above, such features as described by the claims render the claims indefinite.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Severson whose telephone number is (571) 272-2209. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey, can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeremy R Severson/

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Examiner, Art Unit 3653

/Patrick H. Mackey/

Supervisory Patent Examiner, Art Unit 3653